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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,722	10/13/2003	Steven M. Benedetti	0275M-000750	4344

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EXAMINER
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MILLS, DANIEL J

ART UNIT	PAPER NUMBER
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3679

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/684,722

Applicant(s)

BENEDETTI ET AL.

Examiner

Daniel J. Mills

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 29-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restriction***

Claims 29-33 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected method of manufacture, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 6/16/2005.

Applicant's election with traverse of Invention I, an automotive fastener apparatus, in the reply filed on 6/16/2005 is acknowledged. The traversal is on the ground(s) that both inventions are related to the art of automotive fasteners and therefore the search would be coextensive. Because of a coextensive search there would be no serious burden on the examiner. This is not found persuasive because applicants have failed to show that a coextensive search is a reason for not making a restriction requirement. Further, applicants have failed to show that the search, in fact, is coextensive or that "search" is the only criteria in determining "serious burden". Nevertheless, given that patentability for process claims is based on process steps irrespective of recited structure, and patentability for product claims is based on structure irrespective of recited process steps, it is readily apparent that a serious burden on the examiner would exist to search and examine (including consideration of and response to any arguments presented) claims drawn to two patentably distinct inventions in the same application, especially when patentability is predicated on two different sets of criteria.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 11-21, and 23-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Gronau et al. (US 5,542,158) (referred to herein as "Gronau"). Please note the marked-up attachment on page 13 of the instant Office action.

As to claim 1, Gronau discloses a fastener comprising a first portion (14) having a flexible skirt (18) and at least two support posts (D) distally extending from a first side of the flexible skirt, and a second portion (20) permanently joined (when assembled as in figure 3) with the first portion and having at least two deflection wings (A) extending from the first side of the flexible skirt and at least one substantially U-shaped member (24) freely extending from a second side of the flexible skirt.

As to claim 2, Gronau discloses a fastener wherein the first portion comprises a polymeric molding (column 2 line 46)

As to claim 3, Gronau discloses a fastener wherein the second portion comprises a metal (column 3 line 5)

As to claim 4, Gronau discloses a fastener wherein each deflection wing (A) comprises a fixed end (E) integrally joined to a distal end (C) of the second portion, and a displaceable end (B), wherein the displaceable end of a first one of the deflection

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wings is spatially separable (as can be seen, both ends - B are separable) from the displaceable end of a second one of the deflection wings.

As to claim 5, Gronau discloses a fastener wherein each deflection wing comprises, a first bend (E) adjacent the distal end of the second portion, a deflection wing body (F) angularly directable by the first bend away from a plane (defined by 10) formed in parallel with the distal end of the second portion, and a second bend (G) located at a junction between the deflection wing body and the displaceable end, the second bend angularly directing the displaceable end toward the support posts (in as much as the second bend of applicant's invention does).

As to claim 6, Gronau discloses a fastener comprising the first one of the deflection wings (A1) being positionable on a first side of the plane formed in parallel with the distal end of the second portion, and the second one (A2) of the deflection wings being positionable on a second side of the plane (defined by 10) formed in parallel with the distal end of the second portion (as can be seen in figure 3, the first wing is positionable only on the first side of 10 while the second wing has an extension - connecting the 24 with the wing, that is positionable above the second side of the plane 10).

As to claim 7, Gronau discloses a fastener, comprising a plate portion (C is a curved plate) adjacent the distal end of the second portion, the plate portion operable to integrally support the fixed end of each deflection wing.

As to claim 8, Gronau discloses a fastener comprising a bridge (H) connectably joining a distal end of each of the support posts, the bridge being insert moldable with the plate portion.

As to claim 11, Gronau discloses a fastener wherein each U-shaped member (24) comprises at least one toothed retention element (28).

As to claim 12, Gronau discloses a one-piece apparatus for joining accessories to vehicles, the apparatus comprising a polymeric first portion (14) including a flexible skirt (18) a pair of support posts (D) extending substantially perpendicularly from a side of the skirt, and a bridge (H) connectably joining distal ends of each of the support posts and a metallic second portion (20) including an end portion (22) partially insert moldable into the bridge, the end portion having a pair of integrally connected metallic deflectable wings (A), the deflectable wings extendable toward the flexible skirt.

As to claim 13, Gronau discloses an apparatus wherein the second portion comprises a head (J) having at least one engagement member (24).

As to claim 14, Gronau discloses an apparatus wherein the second portion (20) comprises a central portion (22) insert moldable with the support posts, the central portion integrally joined to the head (J) and extending from the head through the flexible skirt.

As to claim 15, Gronau discloses an apparatus wherein each engagement member (24) comprises a substantially U-shaped clip having an open end facing away from the flexible skirt, and a bight (26) formed between a junction of an opposed pair of clip bends, the bight including at least one barb.

As to claim 16, Gronau discloses an apparatus wherein the polymeric first portion comprises a polyamide material (column 2 line 45)

As to claim 18, Gronau discloses a fastener system comprising a vehicle body panel (10), a one piece fastener (when assembled) having a metallic portion (20) insert moldable with a polymeric moldable portion (14), at least one U-shaped member (24) of the metallic portion operably receiving a fixed rib (30) connectably joined to a trim piece (32), and a pair of support posts (D) insert moldable with the moldable portion and operably engageable within a substantially rectangular aperture of the body panel (10), wherein the deflectable wings operably deflect toward each other upon penetration of the support posts within the aperture and expand away from each other by spring force to releasably engage the fastener with the body panel.

As to claim 19, Gronau discloses an apparatus wherein the at least one U-shaped member (24) comprises a pair of U-shaped members (24), each having a bight (26) section to releasably engage the trim piece.

As to claim 20, Gronau discloses an apparatus wherein the bight (26) section includes at least one barb (28).

As to claim 21, Gronau discloses an apparatus comprising a central barb (K) formed between the two members (K appears in figure 1 at least partly between the two U-shaped members).

As to claim 23, Gronau discloses an apparatus wherein each of the support posts (D) include a width smaller than a rectangular aperture width permitting an angular

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rotation of the support posts within the rectangular aperture (as can be seen, the support posts have a tapered section width smaller than the aperture).

As to claim 24, Gronau discloses an apparatus wherein the moldable portion (14) includes a flexible skirt (18) operably contacting the vehicle body panel in a fully engaged position of the one piece fastener.

As to claim 25, Gronau discloses an apparatus wherein the fixed rib is insert moldable with a doghouse assembly (L), the doghouse assembly being positionable between the fixed rib and the trim piece.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gronau (US 5,542,158) as applied to claims 1-8, 11-21, and 23-25 above, and in further view of Okada (US 4,865,505).

As to claim 9, Gronau discloses a fastener with two support posts (D) distally extending from a first side of the flexible skirt with the second portion insert moldable. Gronau fails to disclose that these support posts have a T-shaped cross section.

Okada teaches support posts with T-shaped cross sections (3b at the end of the engagement legs) for the purpose of mounting engagement legs (13) to the support



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posts. Accordingly it would have been obvious to one of ordinary skill in the panel clip art at the time of applicant's invention to modify the arrangement of Gronau to include a T-shaped support post cross-section as taught by Okada, for the purpose of mounting engagement legs to the posts.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gronau (US 5,542,158) as applied to claims 1-8, 11-21, and 23-25 above, and in further view of Smith et al. (US 6,381,811).

As to claim 10, Gronau discloses a fastener with two support posts (D) distally extending from a first side of the flexible skirt with the second portion insert moldable. Gronau fails to disclose that these support posts have a beveled end.

Smith teaches the use of support posts with beveled ends for the purpose of easier insertion of the clip into a panel. Accordingly, it would have been obvious to one of ordinary skill in the panel clip art at the time of applicant's invention to modify the arrangement of Gronau to include support posts with beveled ends as taught by Smith for the purpose of easier insertion of the clip into a panel.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gronau (US 5,542,158) as applied to claim 18 above, and in further view of Smith et al. (US 6,381,811).

As to claim 22, Gronau discloses a fastener system with two support posts (D) distally extending from a first side of the flexible skirt with the second portion insert moldable. Gronau fails to disclose that these support posts have a beveled end.

Smith teaches the use of support posts with beveled ends for the purpose of easier insertion of the clip into a panel. Accordingly, it would have been obvious to one of ordinary skill in the panel clip art at the time of applicant's invention to modify the arrangement of Gronau to include support posts with beveled ends as taught by Smith for the purpose of easier insertion of the clip into a panel.

Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gronau (US 5,542,158).

As to claims 16 and 17, Gronau discloses the apparatus, as previously noted above, with the exception of specifying the material of the first portion as a polyamide and the second portion as stainless steel. Gronau discloses that the material of the first portion is composed of a flexible plastic material, and that the second portion is composed of a pliable metal. Gronau does not specify a polymide for the first portion (claim 16), or a stainless steel for the second portion (claim 17). However, both polymide materials and stainless steel materials are well known per se and commercially used due to their low cost, ease of use, strength, and durability. The selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). Accordingly it would have been obvious to one of ordinary skill in the panel clip art to utilize a polyamide (NYLON) material as the plastic material of the first portion for its ease of production and low cost. Further, it would have also been obvious to utilize stainless steel for its strength and durability as well as its well known resistance to corrosion (especially necessary in an automotive application). The

selection of these known materials for their known properties produces no new and unexpected results.

Claims 26-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gronau (US 5,542,158).

As to claim 26, Gronau discloses the apparatus, as previously noted above, with the exception of specifying the insertion pressure at which the wings deflect.

It has generally been recognized that the optimization of a result effective variable, in this case the assembly force, in a prior art device through routine experimentation, is a design consideration within the level of skill in the art. In re Reese, 290 F.2d 839, 129 USPQ 402 (CCPA 1961). Therefore, it would have been no more than an obvious matter of engineering design choice to one with ordinary skill in the art at the time the invention was made to provide an assembly force of the insertion of the fastener system of Gronau to be up to 15 pounds as determined through routine experimentation and optimization, producing no new and unexpected results.

As to claim 27, Gronau discloses the apparatus with the exception of specifying the fastener insertion pressure.

It has generally been recognized that the optimization of a result effective variable, in this case the assembly force, in a prior art device is a design consideration within the level of skill in the art. In re Reese, 290 F.2d 839, 129 USPQ 402 (CCPA 1961). Therefore, it would have been no more than an obvious matter of engineering design choice to one with ordinary skill in the art at the time the invention was made to provide an assembly force of the insertion of the fastener system of Gronau to be 10

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pounds as determined through routine experimentation and optimization, producing no new and unexpected results.

As to claim 28, Gronau discloses the apparatus with the exception of specifying the minimum fastener removal pressure.

It has generally been recognized that the optimization of a result effective variable, in this case the assembly force, in a prior art device is a design consideration within the level of skill in the art. In re Reese, 290 F.2d 839, 129 USPQ 402 (CCPA 1961). Therefore, it would have been no more than an obvious matter of engineering design choice to one with ordinary skill in the art at the time the invention was made to provide a removal force of the fastener system of Gronau to be at least 35 pounds as determined through routine experimentation and optimization, producing no new and unexpected results.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Higgins (US 5,533,237), Smith (US 5,987,714), Friedrich (US 6,253,423), Smith et al. (US 6,497,011 and US 6,527,471), and Smith (US 6,568,045) are cited for pertaining to the panel clip state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Mills whose telephone number is 571-272-8115. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*DJM*

DJM  
6-28-2005



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U.S. Patent

Aug. 6, 1996

5,542,158

